

**REMARKS**

In the Office Action mailed March 3, 2008 from the United States Patent and Trademark Office, claims 20-29 were rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter, claims 1, 3-6, 12-13, 15-19, 20, and 22-24 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2004/0267876 to Kakivaya et al. (hereinafter "Kakivaya") in view of U.S. Patent Application Publication No. 2005/0090242 to Kotzin et al. (hereinafter "Kotzin"), claims 10 and 28 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Kakivaya and Kotzin in view of U.S. Patent Application Publication No. 2004/0054807 to Harvey et al. (hereinafter "Harvey"), claims 2, 11, 14, 21, and 29 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Kakivaya and Kotzin in view of U.S. Patent No. 6,601,093 to Peters (hereinafter "Peters"), and claims 7-9 and 25-27 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Kakivaya and Kotzin in view of U.S. Patent Application Publication No. 2004/0064575 to Rasheed et al. (hereinafter "Rasheed").

Applicant respectfully provides the following:

**Rejections under 35 U.S.C. § 101:**

In the Office Action, claims 20-29 were rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Specifically, it was indicated that the specification includes non-tangible embodiments within the definition of computer readable medium. Applicant does not intend to claim any non-tangible embodiments for "computer readable media," and has amended the specification to remove any references to non-tangible embodiments for such. Applicant has also amended the claims to begin by reciting "a computer readable medium." Applicant therefore respectfully requests removal of all rejections under 35 U.S.C. § 101.

Rejections under 35 U.S.C. § 103(b):

In the Office Action, claims 1, 3-6, 12-13, 15-19, 20, and 22-24 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Kakivaya in view of Kotzin, claims 10 and 28 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Kakivaya and Kotzin in view of Harvey, claims 2, 11, 14, 21, and 29 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Kakivaya and Kotzin in view of Peters, and claims 7-9 and 25-27 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Kakivaya and Kotzin in view of Rasheed.

Each of the rejections relies in part on Kotzin. Kotzin matured from an application filed on October 24, 2003. The instant application was filed on January 14, 2004. Applicant has submitted herewith a declaration by Michael F. Krieger under 37 C.F.R. § 1.131 showing conception of the invention at least as early as August 13, 2003 (Paragraph 3) with diligence in preparing and filing the application from at least that date until the filing of the application on January 14, 2004 (Paragraphs 4-6). Therefore, Kotzin is not prior art under 35 U.S.C. § 102(e), and all rejections dependent thereon should be removed.

As set forth in the Declaration, Mr. Krieger was personally and materially involved in the preparation of the instant patent application. (Paragraph 2) A disclosure document that resulted in the instant application was received by Kirton & McConkie along with two other disclosures by the same inventor on August 20, 2003. (Paragraph 3) Three patent applications were prepared based on the three disclosure documents. (Paragraphs 4-5) The patent applications for the other two disclosures were completed first, resulting in filings dated November 13, 2003 and December 17, 2003. (Paragraph 4) The instant patent application was completed last, and was filed on January 14, 2004. (Paragraph 5) During the entire time between the reception of the

August letter and the filing of the instant application, Kirton & McConkie diligently sought to prepare the three patent applications. (Paragraph 6)

The above facts clearly set forth diligence in preparing the patent application from a time prior to the filing of Kotzin until the filing of the instant application. Conception is also clearly shown at least as early as the receipt of the complete disclosure document. As set forth in the M.P.E.P., the diligence of an attorney in preparing and filing the patent application inures to the benefit of the inventor. (M.P.E.P. § 2138.06) The M.P.E.P. also sets forth that showing work on related cases and/or work on a backlog of unrelated cases taken up in chronological order is sufficient to show diligence. (M.P.E.P. § 2138.06) As this is exactly what has been shown in the attached Declaration, Applicant respectfully submits that prior invention by Applicant has been shown, and that Kotzin is therefore not prior art. Applicant therefore respectfully requests removal of all rejections under 35 U.S.C. § 103(a) relying on Kotzin.

In addition, M.P.E.P. § 2141 sets forth the *Graham* factual enquiries that should be considered when making an obviousness rejection under Section 103: 1) ascertaining the scope and content of the prior art; 2) ascertaining the differences between the claimed invention and the prior art; and 3) resolving the level of ordinary skill in the pertinent art. (Citing *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966).) In addition, M.P.E.P. §§ 2141 and 2142 set forth that “the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit.” (Citing *KSR International Co. v. Teleflex Inc.* (KSR), 550 U.S. \_\_\_, 82 USPQ2d 1385 (2007).)

For a rejection under Section 103 to stand, it must explicitly set forth 1) factual findings showing that each claim element was known in the art at the time of the invention, and 2) factual findings showing that one of ordinary skill in the art, at the time of the invention, would have

found it obvious to modify or combine the teachings to arrive at the claimed invention. (See, for example, the enumerated required articulations set forth in M.P.E.P. § 2143 for each lettered rationale.)

Applicant respectfully submits that the references in the Office Action, either alone or in combination, do not teach or suggest all the limitations claimed in the claim set provided herein. Specifically, regarding claims 2, 11, 14, 21, and 29, the claims were rejected in part over Peters, with the Office Action indicating that Peters teaches using a randomized exponential backoff strategy. Claim 2 requires “wherein the request is further made using a randomized exponential backoff strategy.” The limitations of the other cited claims is similar. Applicant respectfully submits that while Peters teaches an exponential random-backoff delay, Peters does not teach a request made using a randomized exponential backoff strategy. Peters explicitly teaches that the exponential random-backoff delay is utilized in the event that two devices establish communications, exchange discovery messages, and both have a conflicting self-assigned address so that one must change. (Col 9 lines 5-7) The exponential random-backoff delay of Peters is therefore utilized only after a connection is made and it is determined that one of the two devices needs to change its address (see Figure 3) so that both devices do not try to simultaneously change their addresses. (Col 9 lines 7-11) Thus Peters fails to teach the claim limitation of claim 2 of “wherein the request is further made using a randomized exponential backoff strategy.” Claims 11, 14, 21, and 29 recite similar limitations. Claims 2, 11, 14, 21, and 29 are therefore allowable for at least this additional reason.

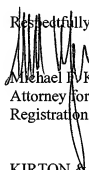
For at least the above reasons, Applicant respectfully submits that all rejections under 35 U.S.C. § 103(a) have been overcome, and respectfully requests the removal of such rejections.

**CONCLUSION**

Applicant submits that the amendments made herein do not add new matter and that the claims are now in condition for allowance. Accordingly, Applicant requests favorable reconsideration. If the Examiner has any questions or concerns regarding this communication, the Examiner is invited to call the undersigned.

DATED this 23 day of May, 2008.

Respectfully submitted,

  
Michael J. Krieger  
Attorney for Applicant  
Registration No.: 35,232

KIRTON & McCONKIE  
1800 Eagle Gate Tower  
60 East South Temple  
Salt Lake City, Utah 84111  
Telephone: (801) 321-4814  
Facsimile: (801) 321-4893